<u>REMARKS</u>

Claims 1-48 are pending in this application. The application has been carefully reviewed in light of the Office Action mailed on April 21, 2005. Reconsideration of all outstanding rejections in light of the following remarks is respectfully requested.

Claims 1-3, 10, 11, 24-26, 32-34 and 48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Cromer *et al* (U.S. Patent 6,314,455)(hereinafter "Cromer"). Reconsideration is respectfully requested.

Claim 1 recites "A method of recovering from a corrupt computer system BIOS comprising the steps of: … if said BIOS is corrupt: initializing components in a boot block of said computer system sufficient to establish a communications connection with a recovery server …."

The Office Action at page 2 states that Cromer discloses "initializing components in a boot block of said computer system sufficient to establish a communications connection with a recovery server" at Cromer, Fig. 4, 412, 422. However, Cromer's system initializes components within a network adapter (Fig. 3, 322) to establish communication, not a boot block (Fig. 2, 245). Cromer is silent as to what component within Cromer's system "establish[es] a communication connection with a recovery server", disclosing, e.g., "start client log-on to server over network" such as in FIG. 4, step 422. Moreover, Cromer's system discloses flash memory 242 and a boot block 245, where the flash memory is disclosed to have only two segments of code (COL. 4, lines 33-39), neither of which "establish a communications connection with a recovery server…", as in claim 1. Finally, Cromer will only operate if "corrupted POST code" is detected, not a corrupted BIOS code. (e.g., COL. 3, lines 30-35)

In particular, Cromer, Fig. 4 discloses "a high level flow chart which depicts a client computer system utilizing a recovery flash image received from a server computer system …." (Col. 6, lines 23-26) Fig. 4, step 412 discloses "the client transmitting an error condition to the server indicating that the execution of POST did not successfully

complete." (COL. 6, lines 51-54) Fig. 4, step 422 discloses "if a determination is made *that image recovery bit 322 is set*, the process passes to block 422 which depicts the client starting a log-on process to the server over the network." (COL. 6, lines 59-63) Cromer at COL. 6, lines 15-22 discloses "an image recovery bit which is utilized by POST to determine if client 104 is to update POST utilizing recovery flash code stored in recovery flash memory 247. When bit 322 is set, the recovery flash image stored in memory 247 is copied to flash 242 and utilized to execute POST on a client 104. When bit 322 is not set, the recovery flash image stored in memory 247 is not utilized to execute POST on the client.". Further, Cromer discloses "flash memory 242 includes a boot block 245. Boot block 245 is storage which includes a small segment of code sufficient to bring up the client computer system 104, and to initiate a copying of a new flash image from a floppy drive." (Cromer, COL. 4, lines 34-38).

Consequently, Cromer discloses that "initializing components ... of said computer system sufficient to establish a communications connection with a recovery server" is not done in the boot block (Fig. 2, 245) but rather in the network interface card (Fig. 3, 322). Further, Cromer discloses only two "segments of code" in "boot block 245", neither of which include code for "initializing components in a boot block of said computer system sufficient to establish a communications connection with a recovery server ..." as in claim 1.

The Office Action suggests on page 20, paragraph 36 that "the flash image refers to the image stored in flash memory, said flash memory storing the BIOS and the book block" citing COL 4 of Cromer. Cromer appears to give separate meaning to the terms BIOS and POST (COL. 4, lines 29-37 discussing BIOS and not including POST therein). In fact, the Office Action recognizes that POST and BIOS are in fact two separate and distinct sets of flash code (citing Cromer, COL. 2, line 4) on page 18, paragraph 33 referring to both "POST and BIOS". Applicant notes that nowhere in COL. 4 of Cromer does it clearly state that the flash image Cromer's system is downloading is the BIOS system, rather than merely the POST system. In fact, the Office Action's contention

on page 20, paragraph 36 that "the flash image" includes both the BIOS and POST code fails explain why Cromer in COL 1, lines 57-COL 2, line 10 refer to BIOS and POST as separate code, then Cromer goes on to repeatedly discuss, e.g., execution of "recovery POST code" (Abstract). Moreover, the Office Action makes an improper inherency argument by concluding that the provision of Cromer stating "POST and BIOS are both typically stored as a single flash image in a storage device such as a flash memory" means that when POST recovery is done, then BIOS recovery is inherent to such a transmission. The fact that code is stored in an "image" in flash memory does not necessarily require that they be an indivisible code that cannot be updated separately. In fact, memory images can contain a plurality of code that are separable and distinct from each other. Cromer recognizes this by repeatedly referring to recovering the POST code, without reference to BIOS code.

MPEP 2112 (8th ed. 2004) provides the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Office Action has failed to establish that a flash image necessarily includes an indivisible or inseparable combination of both the POST and BIOS code and that a reference in Cromer to downloading of POST code necessarily means a download of BIOS code. Accordingly, the Office Action makes an improper assertion of inherency without the necessary basis to support such an assertion.

Based on the above reasons, claim 1 is allowable over Cromer.

Claims 2-9 and 49-50 depend from claim 1, thus are allowable along with claim 1 for at least the reasons noted above.

Applicant notes that the above discussion about how Cromer fails to disclose recovery of a BIOS code and a lack of a showing of inherency with respect to the Office Action's argument that POST code necessarily includes the BIOS code is equally applicable all rejections where the Office Action asserts that POST includes BIOS in "the flash" memory that is downloaded.

Claim 10 recites, *inter alia*, "a method of recovering from a corrupt computer system BIOS comprising the steps of: receiving at a server a request for an uncorrupted version of a BIOS transmitted by a computer system with a corrupted version of said BIOS detected during startup; receiving system information from said computer system; and responsive to said system information, transmitting an uncorrupted version of said BIOS to said computer system." As noted above, Cromer will only operate if "corrupted POST code" is detected, not a corrupted BIOS code. (e.g., COL. 3, lines 30-35). Thus, claim 10 is allowable over Cromer.

Claims 11-14 depend from claim 10, thus are allowable along with claim 10 for at least those reasons noted above.

Claim 24 recites, *inter alia*, "a system for recovering from a corrupted computer system BIOS comprising: ... a BIOS recovery program; a BIOS storage area containing said BIOS; ... a first communications system; and a recovery server, said recovery server comprising: a processor; ... wherein said processor of said computer system, in response to detecting a corrupt version of said BIOS detected during startup, said processor adapted to execute said BIOS recovery program to: initialize in a boot block of said computer system, said chipset, RAM, and first communications system; ... connect to said recovery server through said first and second communications systems; ... download from said recovery server an uncorrupted version of said BIOS based on said system information ...."

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The Office Action at page 2 states that Cromer discloses "initializing components in a boot block of said computer system sufficient to establish a communications connection with a recovery server" at Cromer, Fig. 4, 412, 422. However, Cromer's system initializes components within a network adapter (Fig. 3, 322) to establish communication, not a boot block (Fig. 2, 245). Further, Cromer is silent as to what component within Cromer's system "initialize in a boot block of said computer system, said chipset, RAM, and first communications system; ... connect to said recovery server through said first and second communications systems; ... download from said recovery server an uncorrupted version of said BIOS based on said system information ...." Additionally, Cromer's system discloses flash memory 242 and a boot block 245, where the flash memory is disclosed to have only two segments of code (COL. 4, lines 33-39), neither of which, *inter alia*, "initialize in a boot block of said computer system, said chipset, RAM, and first communications system; ... connect to said recovery server through said first and second communications systems ...", as in claim 24. Finally, Cromer will only operate if "corrupted POST code" is detected, not a corrupted BIOS code. (e.g., COL. 3, lines 30-35) Cromer appears to give separate meaning to the terms BIOS and POST. (e.g., COL. 4, lines 29-37 discussing BIOS and not including POST therein). Accordingly, claim 24 is allowable over Cromer.

Claims 25-31 depend from claim 24, thus are allowable along with claim 24, for at least the reasons noted above.

Claim 32 recites, *inter alia*, "a system for recovering from a corrupted computer system BIOS comprising: ... a processor, ...wherein said computer system's processor, in response to detecting a corrupt version of said BIOS during startup, said processor adapted to execute said BIOS recovery program to: initialize in a boot block of said a chipset of said computer system, said RAM, and said first communications system; locate a recovery server; connect to said recovery server through said first communications system; send system information to said recovery server; download from said recovery server an uncorrupted version of said BIOS based on said system information ...."

The Office Action at page 2 states that Cromer discloses "initializing components in a boot block of said computer system sufficient to establish a communications connection with a recovery server" at Cromer, Fig. 4, 412, 422. However, Cromer's system initializes components within a network adapter (Fig. 3, 322) to establish communication, not a boot block (Fig. 2, 245). Further, Cromer is silent as to what component within Cromer's system "initialize in a boot block of said computer system, said chipset, RAM, and first communications system; ... connect to said recovery server through said first and second communications systems; ... download from said recovery server an uncorrupted version of said BIOS based on said system information ...." Additionally, Cromer's system discloses flash memory 242 and a boot block 245, where the flash memory is disclosed to have only two segments of code (COL. 4, lines 33-39), neither of which, *inter alia*, "initialize in a boot block of said computer system, said chipset, RAM, and first communications system; ... connect to said recovery server through said first and second communications systems ...", as in claim 24. Finally, Cromer will only operate if "corrupted POST code" is detected, not a corrupted BIOS code. (e.g., COL. 3, lines 30-35) Cromer appears to give separate meaning to the terms BIOS and POST. (e.g., COL. 4, lines 29-37 discussing BIOS and not including POST therein). Accordingly, claim 32 is allowable over Cromer.

Claim 48 recites "a system for recovering from a corrupted computer system BIOS comprising a computer system, said computer system comprising a BIOS and components sufficient in a boot block to enable recovery of an uncorrupted BIOS from a remote server ...." As noted above, Cromer does not disclose, *inter alia*, "a BIOS and components sufficient in a boot block to enable recovery of an uncorrupted BIOS from a remote server ...." Further, Cromer does not disclose, *inter alia*, "detecting a corrupt version of said BIOS during startup ...", but rather detects a corrupt POST code. Accordingly, claim 48 is allowable over Cromer for the above reasons, and for other reasons.

Claims 15-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cromer in view of Aoki (JP409258965A). Claim 15 recites, *inter alia*, "a method for recovering from a corrupt BIOS comprising the steps of: ... initializing components in a boot block of said computer system sufficient to establish a communications connection with a recovery server ...."

The Office Action at page 6 states that Cromer discloses " ... if said BIOS is corrupt: initializing components in a boot block of said computer system sufficient to establish a communications connection with a recovery server, locating a recovery server, connecting to said recovery server and sending system information to said recovery server (Figure 4, 412, 422) ...."

However, Cromer's system initializes components within a network adapter (Fig. 3, 322) to establish communication, not a boot block (Fig. 2, 245). Further, Cromer is silent as to what component within Cromer's system "establish[es] a communication connection with a recovery server". Additionally, Cromer's system discloses flash memory 242 and a boot block 245, where the flash memory is disclosed to have only two segments of code (COL. 4, lines 33-39), neither of which "establish a communications connection with a recovery server...", as in claim 15. Finally, Cromer will only operate if "corrupted POST code" is detected, not a corrupted BIOS code. (e.g., COL. 3, lines 30-35) Cromer appears to give separate meaning to the terms BIOS and POST. (e.g., COL. 4, lines 29-37 discussing BIOS and not including POST therein).

MPEP § 2143 sets forth the requirements to be shown by the Examiner in order to have successfully established a prima facie case of obviousness. To establish a case of prima facie obviousness: i) there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, ii) there must be a reasonable expectation of success, and iii) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Moreover, MPEP § 2143.01 states that some *additional objective reason* to combine the teachings of references <u>must</u> be shown by the Examiner. That is, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art itself <u>also</u> suggests the desirability of the combination. MPEP § 2143.01 quoting <u>In re Mills</u>, 916 F.2d 680, 682 (Fed. Cir. 1990).

No such teaching, suggestion or motivation is present in the cited references or indefinitely described art (i.e., Cromer's POST recovery system (e.g., Abstract) or Aoki's update system). Without using the present claims as a roadmap, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from the cited references. The rejections are based on an impermissible hindsight reconstruction of the present invention from the cited references. *See* <u>Ex parte Clapp</u>, 227 U.S.P.Q. 972 (Bd. App. 1985) (requiring "convincing line of reasoning" to support obviousness determination). The fact that the present invention was made by the Applicants does not make the present invention obvious; that suggestion or teaching must come from the prior art. *See* <u>C.R. Bard, Inc. v. M3 Systems, Inc.</u>, 157 F.3d 1340, 1352 (Fed. Cir. 1998). *See e.g.* <u>Uniroyal, Inc. v. Rudkin-Wiley Corp.</u>, 837 F.2d 1044, 1051 (Fed. Cir. 1988) (It is impermissible to reconstruct the claimed invention from selected prior art absent some suggestion, teaching or motivation in the prior art to do so).

The Office Action has failed to supply a suggestion or motivation in either Aoki or Cromer to modify the reference or to combine reference teachings. Aoki is an update server which requires a functioning BIOS and Cromer is a system and method that operates only when a "client computer system fails to successfully complete executing POST" (Cromer, Abstract). Thus, if the two systems were combined, the combination would fail to operate and also fails to include all limitations of claim 15. Moreover, the Office Action fails to cite an additional objective reason to combine the references or point to any section of either Cromer or Aoki that suggests the desirability of a combination as stated by the Office Action beyond an unsupported speculation that such a combination can be combined or modified.

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Applicant further notes that the Office Action has wholly failed to address Applicant's previously presented argument that reliance on Aoki is improper under MPEP § 706.02 Reliance Upon Abstracts and Foreign Language Documents in Support of a Rejection asserted in Applicant's February 23, 2005 response. Given that Aoki cannot be relied upon to support a 35 U.S.C. § 103(a) rejection, at least this rejection should be withdrawn or the final rejection be withdrawn and another office action issued in compliance with section 706.02 requirement to obtain a full translation of the entire foreign language application be done. Accordingly, a final rejection is not well founded at least for these reasons. Consequently, claim 15 is allowable over Cromer and Aoki.

Claims 16-23 and 51-52 depend from claim 15, thus are allowable along with claim 15, for at least the reasons noted above.

Claims 40-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cromer. Claim 40 recites "a system for recovering from a corrupted computer system BIOS comprising: a recovery server, said recovery server comprising: a processor; a hard drive containing an uncorrupted version of a BIOS in a boot block for a computer system; ... wherein said recovery server, in response to receiving a request transmitted by said computer system with a corrupted version of said BIOS detected during startup, is configured to connect to said computer system, receive system information from said computer system, and transmit said uncorrupted version of said BIOS to said computer system."

The Office Action at page 10 states that Cromer discloses "a recovery server, said recovery server comprising a ... a storage containing an uncorrupted version of a BIOS in a boot block for a computer system ...." Citing Cromer, Fig. 4, 412, 422. Cromer will only operate if "corrupted POST code" is detected, not a corrupted BIOS code. (e.g., COL. 3, lines 30-35) Cromer appears to give separate meaning to the terms BIOS and POST. (e.g., COL. 4, lines 29-37 discussing BIOS and not including POST therein), as discussed above. Accordingly, claim 40 is allowable over Cromer.

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Claims 41-47 depend from claim 40, thus are allowable along with claim 40, for at least the reasons noted above.

Applicant notes that obviousness rejections for claims 4-9, 12-14, 15-23, 27-31, 35-39, 40-47 and 49-52 take official notice of knowledge or subject matter a person skilled in the art at the time of the invention, then cite to a generic motivation to combine such knowledge or subject matter that fails to establish a prima facia case of obviousness. The Office Action cites motivations that are merely the general benefits of the cited knowledge or subject matter, not a specific suggestion, motivation or teaching to combine them as suggested. As noted above, to establish a case of prima facie obviousness there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Office Action fails to provide a suggestion or motivation to combine reference teachings or modify the references by citing the general benefits alone.

As discussed above, it is impermissible to reconstruct the claimed invention from selected prior art absent some suggestion, teaching or motivation in the prior art to combine references to attain the claimed invention. For example, on page 17, the Office Action states "those skilled in the art will recognize that the invention described herein may be implemented utilizing any type of data communications channel" with respect to claim 29. Such an assertion that any type of data communications channel does not provide a suggestion, teaching or motivation to utilize any type of data communications channel as recited in claim 29, but rather merely states that it is possible to do so. Another example of failure to provide a motivation, suggestion or teaching to modify the references is found on page 16, paragraph 30 of the Office Action where it states "a person of ordinary skill in the art at the time of the invention would have been motivated to connect a server using an ISP because ISPs provide access to the internet, a global communication network that interconnects networks of various design." Again, the Office Action merely states the references can be modified as in the claims, not that there is an actual teaching,

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Accordingly, claims 4-9, 12-14, 15-23, 27-31, 35-39, 40-47 and 49-52 are allowable for at least these reasons.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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